

Appl. No. 10/622,010
Supplemental Response and Amendment to Office Action dated August 22, 2005

REMARKS/ARGUMENTS

Applicant thanks the Examiner for the telephone conference that took place on March 28, 2006. In the telephone conference, various issues relevant to prosecution of the present application were discussed. Applicant provides herewith an amendment to the claims, as suggested by the Examiner in the phone conference. Applicant submits that no new matter has been added by way of the above amendment. Support for the amendment is found in the specification as originally filed. Accordingly, entry of the amendment is respectfully requested.

On December 22, 2005, Applicant filed in the USPTO a Response to the 2nd and non-final Office Action dated August 22, 2005. Applicants reiterate the arguments made in that Response, and furthermore, provide supplemental arguments and a supplemental amendment to the claims, provided herein. Amendments to the claims provided herein are intended to supplement the amendments made in the Response filed December 22, 2005. Entry of the amendment provided herein as well as the amendment in the Response dated December 22, 2005 is respectfully requested.

Any amendment to the claims as provided herein does not represent an acquiescence to any rejection made by the Examiner in any Office Action or to any position taken by the Examiner expressed in the telephone conference that occurred on March 28, 2006. Applicant traverses all objections and rejections to the extent that they may be applied to the claims following entry of the present amendment and the amendment dated December 22, 2005. Applicant respectfully requests reconsideration of the claims in view of the amendments and remarks herein.

THE STATUS OF THE CLAIMS

Claims 1-22 and 24-50 are pending with entry of this amendment. Claim 23 is cancelled with the present amendment. Claims 1 and 24 are amended herein. These amendments are made without prejudice and are not to be construed as abandonment of any subject matter subject matter or agreement with any objection or rejection of record.

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DOOLEY *et al.* (ALONE OR IN COMBINATION WITH LOCKHART *et al.*) DOES NOT TEACH THE INVENTION

In the Office Action dated August 22, 2005, the Examiner rejected claim 1 (and claims dependent on claim 1) under 35 U.S.C. §103(a) as allegedly obvious and unpatentable over Dooley *et al.*, U.S. Patent No. 6,635,423, in view of International Publication WO 97/10365 to Lockhart *et al.* Applicant disagrees, and traverses the rejection. Applicant reasserts the arguments made in the Response filed on December 22, 2005, and further puts forth that the claims as filed are novel and non-obvious.

However, solely for the purpose of advancing the prosecution of the present application, and without acquiescing to the rejection, Applicant has amended claim 1. This amendment removes any alleged lack of clarity in "plurality of nucleic acids" in step (c) by defining the plurality of nucleic acids that can be used to form the array. The use of total cellular RNA, mRNA, cDNA and a wide variety of amplified nucleic acid products (all derived from the biological samples) to form the array finds abundant support in the specification. See, for example, paragraphs 10, 12, 105-116, 192-201, 204-208, and FIGS. 1 (described in paragraph 73), 4, 5 and 6. Claim 23 is cancelled in view of the limitations of that claim are now incorporated into claim 1, and claim 24 has been amended to reflect proper dependency.

Applicant notes that in the phone conference on March 28, 2006, the Examiner stated that in the event that the limitations of claim 23 were incorporated into claim 1, the amended claim 1 would likely be found non-obvious. Applicant respectfully requests reconsideration of the application in view of the amended claim 1.

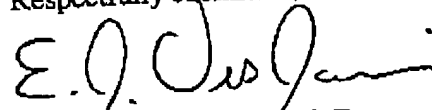
CONCLUSION

In view of the foregoing, Applicant believes that all claims now pending in this application are in condition for allowance. Applicant appreciates the Examiner's help in advancing the prosecution of the application. If the Examiner believes there are any remaining issues regarding the patentability of the pending claims, the Examiner is encouraged to contact the undersigned by telephone to expedite the issuance of a Notice of Allowance.

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Respectfully submitted,



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Attachment: transmittal sheet